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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/642,959	08/21/2000	Bryan K. Choo	E0778	7850
29393	7590	08/16/2004	EXAMINER	
ESCHWEILER & ASSOCIATES, LLC NATIONAL CITY BANK BUILDING 629 EUCLID AVE., SUITE 1210 CLEVELAND, OH 44114			HESSELTINE, RYAN J	
			ART UNIT	PAPER NUMBER
			2623	

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/642,959

Applicant(s)

CHOO ET AL.

Examiner

Ryan J Hesseltine

Art Unit

2623

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): 35 U.S.C. 103 rejection of claim 4.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: 4.Claim(s) rejected: 1-3, 5-13 and 19-26.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

JINGGEWU
PRIMARY EXAMINER

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's arguments on pages 2-4, filed July 2, 2004, have been fully considered but they are not persuasive. On page 2, indented section i., applicant states, "The cited references are directed toward solving different problems and consequently no motivation exists with respect to the nature of the problem to be solved." The examiner respectfully disagrees. IN combination, the two references cited, USPN 6,078,738 to Garza et al. and USPN 5,801,954 to Le et al., disclose all the claimed limitations and applicant has not argued to that fact. Therefore, the problem lies in the motivation to combine said references. Le et al. discloses that "[o]ne of the problems associated with OPC is the lack of an efficient method for checking the design to determine if it will create the desired image since the mask layout design and the printed image are sometimes quite different. Accordingly, it would be a significant advancement in the art to provide a process for checking a mask layout to see if it will produce the desired image which is simple to perform so that changes can be made if necessary" (column 2, line 37-45). The examiner believes that this passage of Le et al. provides excellent motivation to modify Garza et al. in order to achieve the claimed invention. The examiner realizes that Garza et al. discloses evaluating a simulation program and not the evaluation optical proximity corrected designs, but that is the reason it is being combined with Le et al. under 35 U.S.C. Section 103(a). The motivation to combine references does not have to exist in all references being combined. The motivation may be found within a prior art reference (explicitly or implicitly), in the general knowledge of those skilled in the art, or in the nature of the problem to be solved. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In response to applicant's argument that the references are directed toward solving different problems, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The examiner would also like to point out that the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991).

Applicant's arguments on page 5, second paragraph, filed July 2, 2004, with respect to claim 4, have been fully considered and are persuasive. The 35 U.S.C. 103(a) rejection of claim 4 has been withdrawn. The examiner agrees that the phrase "different mask fabrication process" is not inherently vague and that it was adequately described in the specification. The examiner agrees that neither Sugawara nor any of the cited prior art explicitly teaches the "different mask fabrication process" limitation. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.